



10-23-06

Attorney's Docket No.: 21121-002001 / 2301  
(previously 17111-002001 / 2301)

DAE  
JRW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hubert Köster et al.

Art Unit : 1624

Serial No. : 09/067,337

Examiner : Paul V. Ward

Filed : April 27, 1998

Patent No. : 7,094,943

Issue Date : August 22, 2006

Title : SOLUTION PHASE BIOPOLYMER SYNTHESIS

**MAIL STOP PETITIONS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR §1.705(d)**

Applicant hereby petitions for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent at time of issuance. After the granting of the *Petition for Patent Term Adjustment Pursuant to 37 CFR §1.705(b)* at allowance in the amount of 530 days, the present patent went on to issue with 645 days of patent term adjustment. In good faith and candor, applicant requests the review of these additional 115 days accorded between allowance and issuance, and the reconsideration to reduce most recent USPTO Delay entry of 222 days to 0 days, as well as reduce the APPL Delay entry of 107 days to 0 days, resulting in the Total PTA of 530 days, is respectfully requested.

**CERTIFICATE OF MAILING BY "EXPRESS MAIL"**

"Express Mail" Mailing Label Number EV 471529976 US

**Date of Deposit: October 20, 2006**

I hereby certify that this paper is being deposited with the United States Postal "Express Mail Post Office to Addressee" Service under 37 CFR §1.10 on the date indicated above and is addressed to: Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

  
Judy Sherman

Applicant : Hubert Köster et al.  
Patent No. : 7,094,943  
Issued : August 22, 2006  
Serial No. : 09/067,337  
Filed : April 27, 1998  
Page : 2 of 4

Attorney's Docket No.: 21121-002001/ 2301

The Patent Term Adjustment History in the PAIR system reflects that the U.S. Patent and Trademark Office (PTO) calculated the PTA from the time of Allowance until Issuance as follows:

(1) PTO receipt of an *Information Disclosure Statement* on May 8, 2006 after the mailing of the *Notice of Allowance* on February 8, 2006. **Applicant is not in agreement with the APPL Delay of 107 days and contends there should be no APPL delays days as made evident in the remarks below;**

(2) PTO issue date of August 22, 2006, and in consideration of the April 27, 1998 file date (minus the previously adjusted PTO Delay days), 222 additional PTO Delay days were accorded for the PTA 36 month guarantee rule. **In good faith and candor, Applicant is under the impression there should not be any PTO Delay days as a *Request for Continued Examination (RCE)* was filed in this application, thus removing Applicant's eligibility to receive such PTO delay days calculated into the adjustments at issuance.**

### **REMARKS**

For consideration of this *Petition*, and as a courtesy to the Office, the Applicant has respectfully attached a copy of the *Petition for Patent Term Adjustment Pursuant to 37 CFR 1.705(b)* filed after the allowance of the present case, and the responding *PTA Petition Decision* mailed June 23, 2006. The 1.705(b) *Petition* made several points in recounting a series of events which defined this case as problematic.

In regard to calculation point (1) above and the *Information Disclosure Statement* in question, Applicant contends there was a clerical error in the description entry as the actual documents were part of ongoing "no count" miscellaneous communications and exchanges with Examiner Ward in an effort to get the proper initials on a PTO Form 1449 submitted over five years earlier on January 10, 2001. As mentioned in the previous *Petition*, this application remained in the traditional paper format, required reconstruction, and was assigned to multiple

Applicant : Hubert Köster et al.  
Patent No. : 7,094,943  
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Examiners. The documents faxed directly to Examiner Ward on May 8, 2006, were merely an extension of the many issues that plagued this application and Applicant's continuing diligent efforts to assist the Office in overcoming errors and omissions to reconstruct and produce a viable patent. To further evidence this exchange, the subject matter in the *Interview Summary*, entered on May 9, 2006, was regarding the requested signed PTO Form 1449, and there are two more related "no count" documents which are not entered in the file transaction history. They are (1) Fax from Examiner Ward to Ms. Kidd, with date and time stamp 05/09/06 TUE 14:22, which returned the PTO Form 1449 with two of the requested three initials, and (2) a subsequent Fax from Examiner Ward to Ms. Kidd, with date and time stamp 05/09/06 TUE 15:27 which corrected the Examiner's oversight and returned the PTO Form 1449 with all three of the required initials. For the Office's convenience, copies of all these referenced documents have been attached.

In summation and in consideration of the foregoing clarification regarding errors and omission, Applicant respectfully submits and requests that the determination of the Patent Term Adjustment at Issuance be re-calculated to reflect the PTA as it was adjusted at the time of allowance as follows:

- PTO Delay: 621 days (remove the PTA 36 month 222 days)
- APPL Delay: 91 days (remove the post allowance IDS 107 days)
- Total PTA: 530 days

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Filed : April 27, 1998  
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Attorney's Docket No.: 21121-002001/ 2301

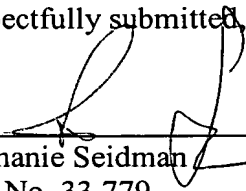
Copies of the following documents are provided in order of reference:

- (1) *Petition for Patent Term Adjustment Pursuant to 37 CFR 1.705(b) at allowance*, and subsequent *PTA Petition Decision* issued by Mr. Fries;
- (2) *Communication memo* regarding the PTO Form 1449 from January 10, 2001, faxed from Ms. Kidd to Examiner Ward on May 8, 2006;
- (3) *Interview Summary* with Ms. Kidd, May 9, 2006, regarding the same PTO Form 1449, and mailed May 10, 2006;
- (4) *Facsimile Communication* from Examiner Ward to Ms. Kidd, with date and time stamp 05/09/06 TUE 14:22; and
- (5) *Facsimile Communication* from Examiner Ward to Ms. Kidd, with date and time stamp 05/09/06 TUE 15:27.

Enclosed is a check for \$200.00 in payment of the petition fee required by 1.18(e). Please apply any other charges or credits to Deposit Account No. 06-1050.

Thank you for your consideration of this Petition. If there should be any questions or additional information required, please call the undersigned.

Respectfully submitted,

  
\_\_\_\_\_  
Stephanie Seidman  
Reg. No. 33,779

Attorney Docket: 21121-002002 / 2301B (prev. 17111-002001 / 2301)  
**Address all correspondence to: Cust. No. 20985**  
Fish & Richardson P.C.  
12390 El Camino Real  
San Diego, California 92130  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099

 **FISH & RICHARDSON P.C.**

225 Franklin Street  
Boston, Massachusetts  
02110-2804

c 209398

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*21121* **COMMISSIONER OF PATENTS AND TRADEMARKS**

**10/20/06**

**\$200.00**

FISH & RICHARDSON P.C.

*17111-002001/jws 2301*

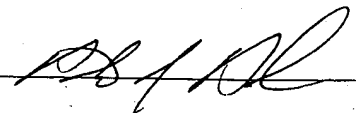
52-153/112



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*09/067337/7,094,943*

⑈ 209398 ⑈ ⑆ 0 1 2 0 1 5 3 9 ⑆ 80 071 123 ⑈

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Hubert Köster et al.                      Art Unit : 1623  
Serial No. : 09/067,337                                  Examiner : Paul V. Ward  
Filed : April 27, 1998  
Title : SOLUTION PHASE BIOPOLYMER SYNTHESIS

**MAIL STOP: PETITIONS / OPLA**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR §1.705(b)**

Applicant hereby petitions for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent at time of allowance. The *Notice of Allowance* and *Determination of Patent Term Adjustment* under 35 U.S.C. 154(b), mailed February 8, 2006, states that the Total Patent Term Adjustment at Allowance is "0" days. Reconsideration of the PTA to reasonably increase USPTO Delay from 412 days to 623 days, decrease APPL Delay from 547 days to 91 days, and increase Total PTA from "0" days to 532 days, is respectfully requested.

The Issue Fee Transmittal along with fee payment for the above-referenced application is also being filed this date under separate cover to Mail Stop Issue Fee.

CERTIFICATE OF MAILING BY "EXPRESS MAIL"  
"Express Mail" Mailing Label Number EV 471535203  
Date of Deposit: May 8, 2006  
I hereby certify that this paper is being deposited with the United States Postal "Express Mail Post Office to Addressee" Service under 37 CFR §1.10 on the date indicated above and is addressed to: Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

  
Judy Sherman

The Patent Term Adjustment History in the PAIR system reflects that the U.S. Patent and Trademark Office (PTO) calculated the PTA as follows:

(1) PTO mailing of an *Office Action/Restriction Requirement* in response to *Election Response* filed August 8, 2001, due on the four-month date of December 8, 2001, and actually mailed on January 16, 2002. **Applicant is in agreement with the PTO Delay of 39 days;**

(2) PTO mailing of an *Office Action/Non-Final Rejection* in response to *Election/Response* filed March 1, 2002, due on the four-month date of July 1, 2002, and actually mailed on July 16, 2002. **Applicant is in agreement with the PTO Delay of 15 days;**

(3) APPL *Response after Non-Final Action* which included an *Information Disclosure Statement*, due at a three-month date of July 21, 2003 and timely received by the PTO on July 17, 2003. The *Information Disclosure Statement* was incorrectly entered as being received on July 17, 2004, according an APPL Delay of 366 days. **Applicant is not in agreement with the calculated APPL Delay of 366 days and contend there should be no APPL delay days as made evident in the comments below;**

(4) PTO mailing of a *Office Action (Restriction Requirement)*, due at a four-month date of November 17, 2003, and actually mailed on November 9, 2004; Applicant acknowledges the accuracy of the accorded PTO Delay of 358 days given the respective dates entered in the file history, however, the *Restriction Requirement* was mailed in error by the new Examiner recently assigned to the application in an attempt to exam and prosecute the application with incomplete (lost or missing) papers. **As the File History entries do not indicate the actual events that transpired, Applicant contends the omissions created a further PTO Delay of 211 days for a total of 569 days for the Office's failure to respond with a proper office action within four months of Applicant's *Response* timely received July 17, 2003;**

(5) APPL *Response to Election / Restriction Filed*, which would appear to have a three-month due date of February 9, 2005, and actually received by the PTO on May 10, 2005 according to the present File History; however, this is not an accurate accounting of the prosecution events. **Applicant is not in agreement with the APPL Delay of 90 days, and contend there should be no APPL delay days as made evident in comments below; and**

Applicant : Hubert Köster et al.  
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(6) APPL *Response and Request for Continued Examination (RCE)*, due on a three-month date of September 9, 2005, and actually received by the PTO on December 6, 2005. Applicant is in agreement with the APPL Delay of 91 days.

### REMARKS

For consideration of this *Petition* and as a courtesy to the Office, the Applicant has respectfully attached a copy of the *Petition for Patent Term Adjustment Pursuant to 37 CFR 1.705(b)* and the *PTA Petition Decision* for the continuation application US Serial No. 09/484,484 (of the instant application) which was also a problematic application and experienced similar tribulations during pre-allowance prosecution due to incomplete files, as these cases remained traditional paper files for some time, and prosecution by at least three different examiners.

As stated in comment (3) above, a *Response and Information Disclosure Statement* were received by the PTO on the same day, July 17, 2003, as evidenced by the attached copy of the Express Mail label, PTO date-stamped return post card, and the Transmittal Letter with a signed Certificate of Mailing. Applicant did not submit an Information Disclosure Statement on July 17, 2004. It appears the error was simply clerical in nature which resulted in a (leap) year or 366 days of APPL Delay. Applicant respectfully requests the 366 days be removed and adjusted to 0 days.

With reference to comment (4) above, and as experienced in the related application, the *Restriction Requirement* was issued erroneously. It was to be based on the original claims and not the pending claims, further evidencing that the PTO file was incomplete at that time after being inactive and set aside upon the departure of the second Examiner Josephine Young. Ms. Young was briefly assigned to the case towards the end of 2002. After Applicant's receipt of the *Restriction Requirement* and during telephonic exchanges with Examiner Ward, it was agreed that the Requirement was erroneously issued and would be withdrawn. A *Notice of Withdrawn Action*, however, was never properly entered or mailed. Again, as with the related application, there is no evidence of this document in the PTO files/IFW. Diligent and a more than reasonable amount of telephone inquiries, discussions, and electronic correspondence with Examiner Ward and his Supervisor, James Wilson, ensued for months requesting a written withdrawal and new action, eventually concluding



with two documented telephonic *Examiner Interview Summaries* with Examiner Ward which were mailed May 19, 2005. One *Interview Summary* was with Ms. Judy Sherman for a telephone interview on May 6, 2005 stating the *Office Action (Restriction)* dated November 9, 2004 would be vacated and no Applicant response was required as there was nothing outstanding; and the second *Interview Summary*, with the undersigned, Dr. Stephanie Seidman, was for a telephone interview on May 10, 2005 and requested a change in a term in the claims to which Applicant agreed and immediately faxed such agreement and amendment directly to Examiner Ward for consideration that date. A copy of each Interview summary is attached for your convenience.

As demonstrated, the November 9, 2004 *Office Action/Restriction* was vacated and no response was outstanding, therefore, the May 10, 2005 entry for a *Response to Election /Restriction Filed* and the APPL Delay of 90 days is an error as referenced in comment (5) above. **Applicant respectfully requests that the 90 days be removed and adjusted to 0 days.**

In conclusion for this series of events, the valid and true PTO action following the Applicant's July 17, 2003 *Response* was a *Final Rejection* mailed June 6, 2005. The Office failed to respond within four months and as such this correct response from the PTO constitutes the actual PTO delay of prosecution by 569 days. **Applicant respectfully requests the additional adjustment of 211 PTO Delay Days to the existing 358 PTO Delay Days accorded November 9, 2004, for a total of 569 PTO Delay Days for the mailing of a proper Office Action/Response.**

In summation and in consideration of the foregoing clarification regarding errors and omission as they relate to the July 17, 2003 *Response* and subsequent PTO lengthy delay in responding, Applicant respectfully submits and requests that the current determination of the Patent Term Adjustment at Allowance be re-calculated as follows:

- PTO Delay adjustment from 412 days to 623 days
- APPL Delay adjusted from 547 to 91 days
- Total PTA be adjusted from "0" days to 532 days

Applicant : Hubert Köster et al.  
Serial No. : 09/067,337  
Filed : April 27, 1998  
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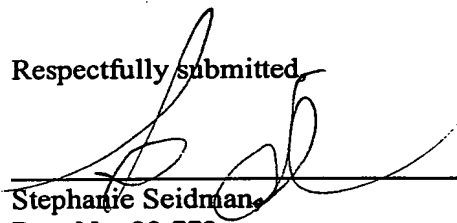
Copies of the following documents are provided in order of reference:

- (1) *Petition for Patent Term Adjustment Pursuant to 37 CFR 1.705(b)*, and *PTA Petition Decision* for related application 09/484,484, reconsidered by Mr. Fries;
- (2) *Transmittal Letter* listing the *Information Disclosure Statement*, page 1 of *Amendment and Response* of July 17, 2003, Express Mail label, and date-stamped postcard.
- (3) *Interview Summary* with Ms. Sherman, May 6, 2005, and *Interview Summary* with Dr. Seidman, May 10, 2005; both mailed May 19, 2005.

Enclosed is a check for \$200.00 in payment of the petition fee required by 1.18(e). Please apply any other charges or credits to Deposit Account No. 06-1050.

Thank you for your consideration of this Petition. If there should be any questions or additional information required, please call the undersigned.

Respectfully submitted,



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Stephanie Seidman  
Reg. No. 33,779

Docket: 17111-002001 / 2301  
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**JUN 23 2006**

**OFFICE OF PETITIONS**

In re Application	:
Koster, et al.	:
Application No. 09/067,337	: DECISION ON APPLICATION
Filed: April 27, 1998	: FOR PATENT TERM ADJUSTMENT
Atty Docket No. 17111-002001	:

This is a decision on the "PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR §1.705(b)", filed May 8, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to five hundred thirty-two (532) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **five hundred thirty (530) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

As a Continued Prosecution Application (CPA) was filed in the instant application on March 12, 2001, the application is entitled to the benefits of the patent term adjustment provisions of 35 U.S.C. §154(b) and 37 C.F.R. §§1.702 through 1.705.<sup>1</sup>

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<sup>1</sup> See MPEP 2730.

On February 8, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days.

On May 8, 2006, Applicants timely<sup>2</sup> submitted the instant application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is one thousand, one hundred sixty-seven (1167) days.

Applicants assert entitlement to a patent term adjustment of five hundred thirty-two (532) days on the basis that the PTO improperly mailed a Restriction Requirement on November 9, 2004. According to applicants, PTO delay should have been assessed using the date that the Office mailed the following Office action, a final rejection, on June 6, 2005, for a period of five hundred sixty-nine (569) days of PTO delay. Moreover, Applicants assert that the ninety (90) days of Applicant delay for responding to the Restriction Requirement on May 10, 2005 was improper. Finally, Applicants point out that they should not have been assessed Applicant delay of three hundred sixty-six (366) days pursuant to 37 C.F.R. §1.704(c)(8) for filing an IDS on July 17, 2004. According to Applicants, the IDS was filed on the same day as the response, on July 17, 2003.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of thirty-eight (38), fifteen, and three hundred fifty-eight (358) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. §1.703(a)(2), reduced by Applicants' delays of three hundred sixty-six (366) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. §1.704(c)(8) and ninety (90) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. §1.704(b). The adjustments of three hundred fifty eight (358), three hundred sixty-six (366) and ninety (90) days are at issue.

With respect to the three hundred sixty-six (366) days of Applicant delay pursuant to 37 C.F.R. §1.704(c)(8), such delay has been found to be in error. A review of the application file

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<sup>2</sup> Applicants filed the application for patent term adjustment together with the payment of the issue fee.

reveals that Applicants did not file an IDS on July 17, 2004, but rather on July 17, 2003. Accordingly, Applicant delay with respect to this filing should have been zero (0) days.

With respect to the three hundred fifty-eight (358) days of PTO delay, the Office was assessed this delay for mailing a Restriction Requirement on November 9, 2004. Applicants were in turn assessed Applicant delay of ninety (90) days for filing a response on May 10, 2005. However, in an Interview Summary mailed on May 19, 2005, the Examiner indicated that the Restriction Requirement was mailed in error, would be vacated, and replaced with an Office action in response to Applicants' July 17, 2003 Amendment. Accordingly, it is concluded that Applicants should not have been assessed ninety (90) days of delay in responding the Restriction Requirement. Moreover, it is concluded that PTO delay in responding to Applicants' July 17, 2003 Amendment should have been assessed using the date the next Office action was mailed, a final rejection on June 6, 2005. In view thereof, PTO delay of five hundred sixty-seven (567) days should have been assessed, not five hundred sixty-nine (569) days as asserted by Applicants.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **five hundred thirty (530) days** (621 (39+15+567) days of PTO delay, reduced by 91 days of applicant delay).

Receipt of the \$200.00 fee set forth in 37 C.F.R. §1.18(e) is acknowledged.

The application is being forwarded to the Office of Patent Publications for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Kery Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen

Day : Thursday  
Date: 6/22/2006

Time: 11:38:23

**PALM INTRANET****PTA Calculations for Application: 09/067337**

Application Filing Date:	04/27/1998	PTO Delay (PTO):	412
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	547
Post-Issue Petitions:	0	Total PTA (days):	530
PTO Delay Adjustment:	665		

**File Contents History**

Number	Date	Contents Description	PTO	APPL	START
106	06/22/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		59	
105	06/22/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	358		
104	06/22/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	366		
91	02/08/2006	MAIL NOTICE OF ALLOWANCE			
90	02/06/2006	ISSUE REVISION COMPLETED			
89	02/06/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
88	02/06/2006	CASE DOCKETED TO EXAMINER IN GAU			
87	02/06/2006	NOTICE OF ALLOWABILITY			
86	02/06/2006	CASE DOCKETED TO EXAMINER IN GAU			
85	01/03/2006	DATE FORWARDED TO EXAMINER			
84	12/06/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
83	01/03/2006	DATE FORWARDED TO EXAMINER			
82	12/06/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)		91	76
81	01/03/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
80	12/06/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
79	12/06/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
78	08/16/2005	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
77	08/15/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
76	06/06/2005	MAIL FINAL REJECTION (PTOL - 326)			
75	05/31/2005	FINAL REJECTION			
74	05/31/2005	DATE FORWARDED TO EXAMINER			

**1.4. // --- 1.0001 / s; Lin / type / DTAT = f<sub>c</sub> / m**

41	09/29/2001	CORRESPONDENCE ADDRESS CHANGE			
40	08/16/2001	CORRESPONDENCE ADDRESS CHANGE			
39	08/16/2001	DATE FORWARDED TO EXAMINER			
38	08/08/2001	RESPONSE TO ELECTION / RESTRICTION FILED			
37	08/08/2001	REQUEST FOR EXTENSION OF TIME - GRANTED			
36	06/05/2001	MAIL RESTRICTION REQUIREMENT			
35	06/04/2001	REQUIREMENT FOR RESTRICTION / ELECTION			
34	03/12/2001	PRELIMINARY AMENDMENT			
33	03/22/2001	DATE FORWARDED TO EXAMINER			
32	03/12/2001	CONTINUING PROSECUTION APPLICATION - CONTINUATION (ACPA)			
31	03/12/2001	MAIL EXPRESS ABANDONMENT (DURING EXAMINATION)			
30	03/12/2001	EXPRESS ABANDONMENT (DURING EXAMINATION)			
29	03/12/2001	WORKFLOW - REQUEST FOR CPA - FINISH			
28	03/12/2001	REQUEST FOR EXTENSION OF TIME - GRANTED			
27	03/12/2001	WORKFLOW - REQUEST FOR CPA - BEGIN			

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### EXPLANATION OF PTE CALCULATION

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Page

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Attorney's Docket No.: 17111-002001/2201

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**OFFICIAL FAX NO: (571) 273-8300**

Number of pages including this page 13

Applicant : Hubert Köster et al.  
Serial No. : 09/067,337  
Filed : April 27, 1998  
Conf. No. : 9981

Art Unit : 1624  
Examiner : Paul V. Ward  
Cust. No. : 20985

Title : SOLUTION PHASE BIOPOLYMER SYNTHESIS

From : Inger D. Kidd on behalf of Stephanie L. Seidman

Message : Please see attached.

10626717.doc

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PAGE 1/10 \* RCVD AT 5/8/2006 6:11:43 PM [Eastern Daylight Time] \* SVR:USPTO-EFAX-S2 \* DNS:2738300 \* CSD:1 858 678 5099 \* DURATION (mm-ss):00-02

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MAY 08 2006

FISH & RICHARDSON,  
SAN DIEGO

\*\*\*\*\*  
\*\*\* TX REPORT \*\*\*  
\*\*\*\*\*

TRANSMISSION OK

TX/RX NO	0502
RECIPIENT ADDRESS	15712732909
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ST. TIME	05/08 15:06
TIME USE	03'53
PAGES SENT	10
RESULT	OK

Attorney's Docket No.: 17111-002001/2301

**OFFICIAL COMMUNICATION FACSIMILE**  
**FOR THE PERSONAL ATTENTION OF:**  
**EXAMINER PAUL V. WARD**  
**UNITED STATES PATENT & TRADEMARK OFFICE**  
**TECHNOLOGY CENTER, 1600**  
**WASHINGTON, D.C. 20231**

**DIRECT FAX NO: (571) 273-2909**

Number of pages including this page 10

Applicant : Hubert Köster et al.  
Serial No. : 09/067,337  
Filed : April 27, 1998  
Conf. No. : 9981

Art Unit : 1624  
Examiner : Paul V. Ward  
Cust. No. : 20985

Title : SOLUTION PHASE BIOPOLYMER SYNTHESIS

From Inger D. Kidd on behalf of Stephanie L. Seidman

Message Please see attached.

10628723.doc

**OFFICIAL COMMUNICATION FACSIMILE**  
**FOR THE PERSONAL ATTENTION OF:**  
**EXAMINER PAUL V. WARD**  
**UNITED STATES PATENT & TRADEMARK OFFICE**  
**TECHNOLOGY CENTER, 1600**  
**WASHINGTON, D.C. 20231**

**DIRECT FAX NO: (571) 273-2909**

**Number of pages including this page** 10

**Applicant** : Hubert Köster et al.  
**Serial No.** : 09/067,337  
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10628723.doc

**NOTE: This facsimile is intended for the addressee only and may contain privileged or confidential information. If you have received this facsimile in error, please immediately call us collect at (858) 678-5070 to arrange for its return. Thank you.**

# FISH & RICHARDSON P.C.

Frederick P. Fish  
1855-1930

W.K. Richardson  
1859-1951

12390 El Camino Real  
San Diego, California  
92130

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Web Site  
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May 8, 2006

Examiner Paul V. Ward  
Technology Center 1600; Art Unit 1624  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

## Re: SOLUTION PHASE BIOPOLYMER SYNTHESIS

**Applicant:** Hubert Köster et al.  
**Application No.:** 09/067,337  
**Filing Date:** April 27, 1998  
**Country:** United States  
**Our Ref.:** 17111-002001/2301



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NEW YORK

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SILICON VALLEY

TWIN CITIES

WASHINGTON, DC

Dear Dr. Ward:

Per your request, enclosed is a copy of the Supplemental Information Disclosure Statement that was previously submitted on January 10, 2001.

As discussed earlier, this Information Disclosure Statement was not initialed and returned. It is listed in the "Transaction History" of PAIR as being received by the PTO. However, the document failed to be scanned into the Image File Wrapper for this application.

To permit you to properly initial and date this Information Disclosure Statement, copies of the following documents are provided: the Transmittal Letter (in duplicate), the Supplemental Information Disclosure Statement, a clean copy of the PTO 1449 form (1 page) to be considered and initialed, the abstracts listed on the PTO 1449 form as items B and C, and the returned postcard dated-stamped as received by the PTO on January 12, 2001.

If you have any questions, please do not hesitate to contact me at my direct dial 858-678-5661. Thank you for your help in this matter.

Sincerely,

Inger D. Kidd  
on behalf of Stephanie Seidman

Enclosures

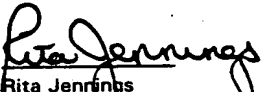
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KOSTER  
Serial No. 09/067,337  
Filed: April 27, 1998  
For: SOLUTION PHASE BIOPOLYMER  
SYNTHESIS  
Art Unit: 1623  
Examiner: Wilson, J.

I hereby certify that this paper and the attached papers are being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents  
Washington, D.C. 20231, on this date.

01/10/01  
Date

  
Rita Jennings

TRANSMITTAL LETTER

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Transmitted herewith are a Supplemental Information Disclosure Statement and a PTO-Form 1449 (1 page) for filing in connection with the above-identified application. Since this Supplemental Information Disclosure Statement is filed after receipt of a first Office Action on the merits for the above-captioned application, the filing fee of \$180.00 is enclosed. If no proper payment is enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-1213 for the appropriate fee as stated below:

- ☒ The Commissioner is hereby authorized to charge any fee, including any submitted herewith that may be due in connection with this and the attached papers, or with this application during its entire pendency to or to credit any overpayment to Deposit Account No. 50-1213. A duplicate of this sheet is enclosed.

Respectfully submitted,  
HELLER, EHRMAN, WHITE & McAULIFFE LLP

By: \_\_\_\_\_  
Stephanie L. Seidman  
Registration No. 33,779

Attorney Docket No.: 24743-2301  
Address all correspondence to:  
Stephanie Seidman, Esq.  
HELLER, EHRMAN, WHITE & McAULIFFE LLP  
4250 Executive Square, 7th Floor  
La Jolla, California 92037-9103  
Telephone: (858) 450-8400  
Facsimile: (858) 587-5360  
EMAIL: sseidman@hewm.com

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KOSTER  
Serial No. 09/067,337  
Filed: April 27, 1998  
For: SOLUTION PHASE BIOPOLYMER  
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By:

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Attorney Docket No.: 24743-2301  
Address all correspondence to:  
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EMAIL: sseidman@hewm.com

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Koster

Serial No.: 09/067,337

Filed: April 27, 1998

For: *SOLUTION PHASE BIOPOLYMER  
SYNTHESIS*

Art Unit: 1623

Examiner: Wilson, J.

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Commissioner for Patents  
Washington, D.C. 20231, on this date.

01/10/01  
Date

*Rita Jennings*  
Rita Jennings

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT IN  
ACCORDANCE WITH 37 C.F.R. §§ 1.97(c)**

Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

Since this Supplemental Information Disclosure Statement is filed after receipt of a first Office Action on the merits for the above-captioned application, the filing fee of \$180.00 is enclosed. If no proper payment is enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-1213.

In accordance with the duty of disclosure imposed by 37 C.F.R. §1.56 to inform the Patent Office of all references known by Applicant or Applicant's representative that may be material to the examination of the subject application, Applicant's representative hereby provides this Supplemental Information Disclosure Statement that is prepared in accordance with 37 C.F.R. §§1.97-1.98.

Form PTO-1449 (1 page) and copies of the cited documents are provided herewith. The enclosed reference items B and C were previously cited in an Information Disclosure Statement mailed November 23, 1999. In an office action mailed September 12, 2000, these references were crossed out by the Examiner on the returned P49 form because the date was not included on the P49 form. Replacement copies of these references are provided and the date for each reference is correctly cited on the P49 form. The cited documents listed on Form PTO-1449 are supplied herewith in the English language.

**U.S.S.N. 09/067,337**

**Koster, *et al.***

**Supplemental IDS**

Hence, in accordance with the requirements of 37 C.F.R. §1.98, as amended effective March 16, 1992, no further explanation of the listed items is necessary.

Although the documents are made known to the Patent and Trademark Office in compliance with Applicant's duty of disclosure, such disclosure is not to be construed as an admission by Applicant or Applicant's representative that any of the references is effective as prior art against the subject application. In accordance with 37 C.F.R. §1.97(h), the filing of this Supplemental Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 C.F.R. §1.56(b) exists.

Applicant respectfully requests that the Examiner review the foregoing references and that they be made of record in the file history of the above-captioned application.

\* \* \*

Respectfully submitted,  
HELLER, EHRMAN, WHITE & McAULIFFE LLP

By:

Stephanie L Seidman  
Registration No. 33,779

Attorney Docket No.24742-2301  
Address all correspondence to:  
Stephanie Seidman, Esq.  
HELLER, EHRMAN, WHITE & McAULIFFE LLP  
4250 Executive Square, 7th Floor  
La Jolla, California 92037-9103  
Telephone: (858) 450-8400  
Facsimile: (858) 587-5360  
EMAIL: sseidman@hewm.com



FORM PTO-1449 (Modified)	ATTY. DOCKET NO. 24743-2301	SERIAL NO. 09/067,337
	APPLICANT KOSTER	
	FILING DATE April 27, 1998	GROUP 1623

LIST OF PATENTS AND PUBLICATIONS FOR  
APPLICANT'S INFORMATION DISCLOSURE  
STATEMENT

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER							DATE	NAME	CLASS	SUB CLASS	FILING DATE
	A	6	0	0	1	9	6	6	12/14/99	Pieken	530	338	08/06/98

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER							DATE	COUNTRY	CLASS	SUB CLASS	Translation Yes No	

\*Derwent English Language Abstract or English Equivalent Provided.

OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

	B	Database WPI, Derwent Publications #199848, citing Japanese Patent No. 10251292, September 22, 1998.
	C	Database WPI, Derwent Publications #199612, citing Japanese Patent No. WO 9603148, February 8, 1996.

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

XP-002118884

1/1 - (C) WPI / DERWENT  
AN - 1998-563156 ç48!  
AP - JP19970055937 19970311  
PR - JP19970055937 19970311  
TI - New branched oligo:nucleotide used as anti-sense  
molecule - can be easily prepared from pentaerythritol  
compound  
IW - NEW BRANCH OLIGO NUCLEOTIDE ANTI SENSE MOLECULAR CAN  
EASY PREPARATION PENTAERYTHRITOL COMPOUND  
PA - (MATS-I) MATSUDA A  
- (TAIH ) TAIHO PHARM CO LTD  
PN - JP10251292 A 19980922 DW199848 C07H21/02 008pp  
ORD - 1998-09-22  
IC - A61K31/70 ; C07F9/09 ; C07F9/22 ; C07F9/40 ; C07H21/02 ;  
C07H21/04 ; C12N15/09  
FS - CPI  
DC - B05 D16  
AB - J10251292 Branched oligonucleotide of formula (I) is  
new. R1, R2 = DNA or RNA; and n = 2-6. Also claimed is  
a pentaerythritol compound of formula (II). Tr = trityl  
(optionally substituted); and A = phosphate,  
phosphonate or phosphoroamidite.  
- USE - The branched oligonucleotide can be used as an  
antisense molecule.  
- ADVANTAGE - The branched oligonucleotide can be  
prepared easily from the pentaerythritol compound.  
- (Dwg.0/2)

1/7/1

DIALOG(R) File 351:DERWENT WPI

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010619839

WPI Acc No: 96-116792/199612

Treatment for diabetes - by tyrosine phosphorylation of novel protein p82

Patent Assignee: ONO PHARM CO LTD (ONOOY )

Inventor: HIRANO A; KITAGAWA K; OHNO H

Number of Countries: 019 Number of Patents: 003

Patent Family:

Patent No	Kind	Date	Applicat No	Kind	Date	Main IPC
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WO 9603148	A1	19960208	WO 95JP1484	A	19950726	A61K-045/00
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199612 B						
JP 8505653	X	19970325	WO 95JP1484	A	19950726	A61K-045/00

199722						
			JP 96505653	A	19950726	

JP 11035479	A	19990209	JP 94194870	A	19940727	A61K-038/00
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199916

Priority Applications (No Type Date): JP 94194870 A 19940727

Cited Patents: 01Jnl.Ref; JP 5202042; JP 5313690; JP 5835164

Patent Details:

Patent	Kind	Lan	Pg	Filing Notes	Application	Patent
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WO 9603148	A1	J	27			
				Designated States (National):	JP	KR US

				Designated States (Regional):	AT	BE CH DE DK ES FR GB GR IE
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IT	LU	MC	NL			
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PT	SE					
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JP 8505653	X			Based on		WO 9603148
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JP 11035479	A		8			
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Abstract (Basic): WO 9603148 A

Treatment for diabetes involving tyrosine phosphorylation of

protein p82 is new. Also claimed is a screening method for diabetes

using p82, an 82 kDa protein, which by tyrosine phosphorylation

activates glycogen synthesis, and an 82 kD protein isolated using

anti-phosphotyrosine antibody after adding insulin to rat Fao cells.

USE - The protein is used in the treatment and screening of

diabetes (claimed). It is also useful in the amelioration of hyperglycaemia.

Dwg.0/0

Derwent Class: B04; D16

International Patent Class (Main): A61K-038/00; A61K-045/00

International Patent Class (Additional): A61K-031/015; A61K-031/05;

A61K-031/135; A61K-031/19; A61K-031/195; A61K-031/235; A61K-031/24;

A61K-031/425; A61K-033/24; A61K-038/17; C07C-039/14; C07C-215/86;

C07C-229/64; C07C-229/70; C07D-417/12; C07K-014/47; C12P-021/00;

G01N-033/68; C07D-277-32; C07D-311-72

INVOICE NUMBER	INVOICE DATE	AMOUNT	DISCOUNT	NET AMOUNT	TOTAL
	1/9/01	COMMISSIONER FOR PATENTS			\$180.00**
	24743-2301	- Supplemental IDS			
PLEASE DETACH BEFORE DEPOSITING				CHECK TOTAL	\$180.00**

Melissa

Heller Ehrman

Heller Ehrman White & McCauley LLP  
4250 Executive Square, 7th Floor  
La Jolla, California 92037-9103

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January 9, 2001

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*Stacy Balle*  
AUTHORIZED SIGNATURE

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January 10, 2001

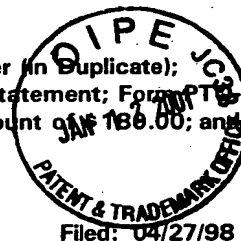
Client No.: 24743-2301  
Enclosures: Transmittal Letter (in duplicate);  
Supplemental Information Disclosure Statement; Form PTO  
1449; 3 cited references; check in amount of \$180.00; and  
Return Postcard

Applicant(s): KÖSTER  
Serial No.: 09/067,337

Filed: 04/27/98

For: SOLUTION PHASE BIOPOLYMER SYNTHESIS

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# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/067,337	04/27/1998	HUBERT KOSTER	17111-002001/24743-2301	9981
20985	7590	05/10/2006	EXAMINER	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			WARD, PAUL V	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Interview Summary</b>	Application No.		Applicant(s)	
	09/067,337		KOSTER ET AL.	
	Examiner		Art Unit	
	PAUL V. WARD		1624	

All participants (applicant, applicant's representative, PTO personnel):

- (1) PAUL V. WARD. (3) \_\_\_\_\_  
 (2) INGER D. KIDD. (4) \_\_\_\_\_

Date of Interview: 09 May 2006.

Type: a) ☒ Telephonic b) ☐ Video Conference  
 c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.  
 If Yes, brief description: \_\_\_\_\_

Claim(s) discussed: \_\_\_\_\_

Identification of prior art discussed: \_\_\_\_\_

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant requested the signed 1449 PTO Form and Examiner agreed to mail form out to Applicant today.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

  
 Examiner's signature, if required

RECEIVED *ST*

MAY 09 2006

FISH & RICHARDSON, P.C.  
SAN DIEGO

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Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Date: 09 May 2006

To: INGER D. KIDD	From: PAUL V. WARD
Application/Control Number: 09/067,337	Art Unit: 1624
Fax No.: 858.678.5099	Phone No.: 571-272-2909
Voice No.: 858-678-5070	Return Fax No.: (571) 273-8300
Re: PTO Form 1449	CC:
<input type="checkbox"/> Urgent <input type="checkbox"/> For Review <input type="checkbox"/> For Comment <input type="checkbox"/> For Reply <input checked="" type="checkbox"/> Per Your Request	

## Comments:

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Commissioner for Patents  
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Sheet 1 of 1

FORM PTO-1449 (Modified)	ATTY. DOCKET NO. 24743-2301	SERIAL NO. 09/067,337
	APPLICANT KOSTER	
	FILING DATE April 27, 1998	GROUP 1623

LIST OF PATENTS AND PUBLICATIONS FOR  
APPLICANT'S INFORMATION DISCLOSURE  
STATEMENT

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE
A	6 0 0 1 9 6 6	12/14/99	Picken	530	338	08/06/98

## FOREIGN PATENT DOCUMENTS

DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	Translation Yes No

\* Derwent English Language Abstract or English Equivalent Provided.

## OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

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C	Database WPI, Derwent Publications #199612, citing Japanese Patent No. WO 9603148, February 8, 1996.

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

05/19/99

7/10 \* RCVD AT 5/8/2006 6:07:23 PM [Eastern Daylight Time] \* SVR:USPTO-EFXXF-6/42 \* DNIS:2732909 \* CSID:1 858 678 5099 \* DURATION (mm-ss):04-00



\*\*\*\*\*  
\*\*\* RX REPORT \*\*\*  
\*\*\*\*\*

RECEPTION OK

TX/RX NO	7336
RECIPIENT ADDRESS	
DESTINATION ID	
ST. TIME	05/09 12:20
TIME USE	02'01
PGS.	2
RESULT	OK

\*\*\*\*\*  
 \*\*\* ERROR TX REPORT \*\*\*  
 \*\*\*\*\*

TX FUNCTION WAS NOT COMPLETED

TX/RX NO 0947  
 CONNECTION TEL 918586785099  
 SUBADDRESS  
 CONNECTION ID  
 ST. TIME 05/09 15:27  
 USAGE T 00'00  
 PGS. 0  
 RESULT NG  
 0 #018

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FISH & RICHARDSON, P.C.  
SAN DIEGO

## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
 United States Patent and Trademark Office  
 P.O. Box 1460  
 Alexandria, VA 22313-1460  
 www.uspto.gov

Fax Cover Sheet

Date: 09 May 2006

To: INGER D. KIDD	From: PAUL V. WARD
Application/Control Number: 09/067,337	Art Unit: 1624
Fax No.: 858.678.5099	Phone No.: 571-272-2909
Voice No.: 858-578-5070	Return Fax No.: (571) 273-8300
Re: PTO Form 1449	CC:
<input type="checkbox"/> Urgent <input type="checkbox"/> For Review <input type="checkbox"/> For Comment <input type="checkbox"/> For Reply <input checked="" type="checkbox"/> Per Your Request	

## Comments:

Here is a the faxed copy and the original will be posted to you today.

Sheet 1 of 1

FORM PTO-1449 (Modified)

LIST OF PATENTS AND PUBLICATIONS FOR  
APPLICANT'S INFORMATION DISCLOSURE  
STATEMENTATTY. DOCKET NO.  
24743-2301SERIAL NO.  
09/067,337APPLICANT  
KOSTERFILING DATE  
April 27, 1998GROUP  
1623

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EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

05/19/98

PAGE 7/10 \* RCVD AT 5/8/2006 6:07:23 PM [Eastern Daylight Time] \* SVR:USPTO-EFXXRF-6/42 \* DNIS:2732908 \* CSID:1 858 678 5099 \* DURATION (mm-ss):04-00

XVJ 63:9T JUL 90/60/90

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\*\*\* RX REPORT \*\*\*  
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RECEPTION OK

TX/RX NO	7343
RECIPIENT ADDRESS	
DESTINATION ID	
ST. TIME	05/09 14:36
TIME USE	02'00
PGS.	2
RESULT	OK